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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,215	03/22/2004	Patrick E. White	00-VE22.03D CON1	3300

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VERIZON
PATENT MANAGEMENT GROUP
1515 N. COURTHOUSE ROAD, SUITE 500
ARLINGTON, VA 22201-2909

EXAMINER	
RIYAMI, ABDULLA A	
ART UNIT	**PAPER NUMBER**
2609	

NOTIFICATION DATE	DELIVERY MODE
08/24/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@VERIZON.COM

Office Action Summary	Application No.	Applicant(s)	
	10/807,215	WHITE ET AL.	
	Examiner	Art Unit	
	Abdullah Riyami	2609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date [redacted].
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Abstract

1. The abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomew et al. (US 6285745 B1) in view of Gordon (5608786).

In claim 1, Bartholomew et al. discloses a method of telecommunication over the Internet comprising the steps of: inputting to a first communication terminal (see figure 8, left side) connected to a first telephone system (see figure 8, left side) a called directory number with a unique identifier; responsive to the unique identifier translating the called directory number to an Internet address (see directory numbers and database, column 28, lines 5-50) for an Internet to telephone system gateway (see column 28, lines 5-50, and figure 8, blocks 408

and 410) capable of serving as a gateway (see column 27, line 49) between the Internet and a second telephone system serving the called directory number; delivering to the second telephone system via the Internet the calling directory number (see column 28, lines 40-59) and establishing through the second telephone system a connection to a second communication terminal identified by the directory number.

Bartholomew et al. does not expressly disclose establishing through the second telephone system a connection to a second communication terminal identified by the directory number.

Gordon discloses a method of telecommunication over the Internet and establishing through the second telephone system a connection (see figure 5, and column 8, lines 62-67 and column 9, lines 1-17) to a second communication terminal identified by the directory number.

Bartholomew et al. and Gordon are analogous art because they are from the same field of endeavor of telephone services using the Internet.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use Gordon' s method for establishing through the second telephone system a connection to a second communication terminal identified by the directory number (see figure 5, and column 8, lines 62-67 and column 9, lines 1-17) in Bartholomew et al.'s a method of telecommunication over the Internet (see figure 8).

The motivation to combine would have been to have cost-effective transfer of voice messages by reducing long distance charges. Thus, the Internet becomes the transport backbone of a global voice system and opens Internet to access by telephones.

Double Patenting

7. This is a non-provisional obviousness-type double patenting rejection because the conflicting claims have in fact been patented.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6711241. Although the

conflicting claims are not identical, they are not patentably distinct from each other because of the following:

For claim 1, claim 1 of U.S. Patent No. 6711241 discloses, a method of real-time interactive voice telecommunication over the Internet comprising the steps of: initiating placement of a telephone call by inputting to a first communication terminal connected to a first telephone system a series of signals that represents the combination of a called directory number portion and a unique identifier portion, the unique identifier indicative that the call is to be routed through the Internet; receiving the series of signals input in the initiating step at which a switch in the first telephone system associated with the first communication terminal, responsive to receipt of the signals, the unique identifier portion initiates the translating of the called directory number portion to an Internet address for an Internet to telephone system gateway capable of serving as a gateway between the Internet and a second telephone system serving the called directory number; delivering to the second telephone system via the Internet the calling directory number portion; and establishing through the second telephone system a connection to a second communication terminal identified by the directory number portion.

Applicant's claim 1 merely broadens the scope of patent number U.S. Patent No. 6711241 claim 1 by eliminating:

"a series of signals that represent the combination."

It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 186 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not needed would have been obvious to one skilled in the art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
A	US-2007/0121591 A1	05-2007	Steven R. Donovan	370/352
B	US-2002/0114324 A1	08-2002	Low et al.	370/352
C	US-6,539,077 B1	03-2003	Ranalli et al.	379/67.1
D	US-5,878,130 A	03-1999	Andrews et al.	379/265.09
E	US-5,915,008 A	06-1999	Dulman, Scott	379/221.08
F	US-6,226,287 B1	05-2001	Brady, Patrick K.	370/352
G	US-2007/0076687 A1	04-2007	Low et al.	370/351
H	US-6,373,929 B1	04-2002	Johnson et al.	379/114.02
I	US-2002/0067739 A1	06-2002	WILKES et al.	370/465

All of the above are cited to teach a method for using the Internet for two-way communications with telephones and cell phones.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abdullah Riyami whose telephone number is (571) 270-3119. The examiner can normally be reached on Monday through Thursday 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dang Ton can be reached on (571) 272-3171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

DANG T. TON
SUPERVISORY PATENT EXAMINER